

REMARKS

Applicants respectfully request that the foregoing amendments be made prior to examination of the present application. These amendments change claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented above, with an appropriate defined status identifier.

Upon entry of the foregoing amendments, claims 1-23 are pending in the application, with claims 1 and 19 being the independent claims. Claims 19-22 are sought to be amended by the present amendment. Claim 23 is sought to be added by the present amendment. Claims 1-18 are withdrawn from further consideration.

Claims 19-22 have been amended to more clearly define Applicants' invention. For example, claim 19 has been amended to recite the phrase "a GLP-1 activity" immediately after "A GLP-1 derivative having," to indicate that the GLP-1 derivative has GLP-1 activity. Claim 19 has also been amended to recite "GLP-1 (7-36) with a modification of the peptide which does not substantially alter the physiological activity thereof." In addition, claim 19 has been amended to more clearly indicate that the GLP-1 derivative comprises an asparagine or aspartic acid substitution at position 34, and a glutamine substitution at position 26, of the GLP-1 peptide. Support for these amendments can be found in the specification as filed, e.g., at page 26, lines 3-12 and 16-27. Claim 22 has also been amended to omit SEQ ID NOs. 2 and 6.

Support for new claim 23 can be found in the specification as filed, e.g., at page 26, lines 12-15.

These changes are believed to introduce no new matter and their entry is respectfully requested.

The Restriction Requirement

In response to the restriction requirement set forth in the Office Action mailed November 29, 2007, Applicants hereby provisionally elect for prosecution the invention of Group V, represented by claims 19-21 and 22 (in part), drawn to a GLP-1 derivative,

including a derivative having the amino acid sequence of SEQ ID NO: 6. As currently presented, claims 19-21 and 23 encompass the elected invention. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed, and Applicants reserve the right to file a divisional application covering the subject matter of the non-elected claims.

This election is made with traverse.

Applicants respectfully submit that the invention of Group V should be examined together with the inventions of Groups III and IV (GLP-1 derivatives, including derivatives having the amino acid sequences of SEQ ID NOs: 2 and 5).

In the November 29, 2007 Office Action setting forth the restriction requirement, the Examiner alleges that the inventions of Groups I-V (including those of Groups III-V) do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical feature. (Office Action, at page 3, lines 1-4.)

Applicants submit that the inventions of Groups III to V are linked by a special technical feature to form a single general inventive concept, and thus should be examined together. The claims of these three groups describe GLP-1 derivatives that have the common special technical feature of being trypsin-resistant. Namely, when lysine at the 34th position in GLP-1 (7-36) is substituted with asparagine or aspartic acid, and lysine at the 26th position is substituted with glutamine, resistance to trypsin is conferred to GLP-1. Claim 21 is a dependent claim which refers to the derivative of claim 19, wherein substitution of alanine at the 8th position with serine or glycine further generates resistance to dipeptidylpeptidase IV. Claim 21 is drawn to a derivative which is not only resistant to trypsin but also to dipeptidylpeptidase IV, and thus also has the common special technical feature of being trypsin-resistant.

Applicants therefore respectfully request that the inventions of Groups III to V (*i.e.*, GLP-1 derivatives, including those of SEQ ID NOs: 2, 5 and 6) be examined concurrently. At the very least, Applicants submit that the election among SEQ ID NOs: 2, 5, and 6 is rather an election of a species rather than an election of a separate invention.

Applicants additionally traverse the restriction requirement on the grounds that the search and examination of Groups III-V is not unduly burdensome. According to the Manual of Patent Examining Procedure (MPEP), section 803, "if a search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent and distinct inventions." (MPEP, 8th Edition (August 2007), § 803, at page 800-4, left-hand column, lines 1-5.) Applicants submit that a search of the inventions of Groups III-V (e.g., SEQ ID NOs: 2, 5 and 6), all of which encompass GLP-1 derivatives, would not impose any burden upon the Examiner, because a search concerning the patentability of the invention of one group is likely to uncover art of interest to the other group. Thus, as above, the Applicants respectfully request that the Examiner examine Groups III to V concurrently in the instant application.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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